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Dkt. 55873-C/JPW/AJM/AAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Ann Marie Schmidt, et al.
U.S. Serial No.: 10/666,513
Filed : September 19, 2003
For : Extracellular RAGE Binding Protein (EN-RAGE) and Uses Thereof

1185 Avenue of the Americas
New York, New York 10036
June 4, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

COMMUNICATION IN RESPONSE TO MAY 6, 2004 OFFICE ACTION

This Communication is submitted in response to a May 6, 2004 Office Action issued by the United States Patent and Trademark Office in connection with the above-identified application. A response to the May 6, 2004 Office Action is due June 6, 2004. Accordingly, this Communications is being timely filed.

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Restriction Requirement

In the Office Action, the Examiner restricted the pending claims to one of the following allegedly distinct inventions under 35 U.S.C. §121:

- I. Claims 1, 2 and 15, drawn to peptides;
- II. Claim 4, drawn to a nucleic acid;
- III. Claim 17, drawn to an antibody;
- IV. Claim 18, drawn to a ribozyme;
- V. Claim 19, drawn to a transgenic animal overexpressing EN-RAGE; and
- VI. Claim 23, drawn to a transgenic animal with reduced levels of EN-RAGE.

In response, applicants hereby elect, with traverse, Group I, claims 1, 2 and 15, drawn to EN-RAGE peptide.

Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination can be made without serious burden.

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The inventions of Groups I-VI are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subject matter claimed. The inventions of Groups I-VI all relate to EN-RAGE peptide. Applicants therefore maintain that groups I-VI are not independent and restriction is not proper.

Furthermore, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims of Groups II-VI would not require a serious burden once the prior art relevant to Group I has been identified. Therefore, there would be no serious burden on the Examiner to examine Groups I-VI together in the subject application. Hence, the Examiner must examine these Groups on the merits.

In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. §121 and respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

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If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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9/19/03
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